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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/544,523

04/06/2000

MIKEL A. LEHRMAN

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7590

04/07/2004

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EXAMINER

WU, DOROTHY

ART UNIT

PAPER NUMBER

2615

DATE MAILED: 04/07/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

MJ

# Office Action Summary

Application No

09/544,523

Applicant(s)

LEHRMAN, MIKEL A.

Examiner

Dorothy Wu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Response to Arguments*

1. The applicant has argued: "Hornback, on the other hand, does not teach or suggest using a housing...that protects, for example, display 200 of photo album 130." While the specification may disclose that the housing be "rigid enough to protect display 104, " the claim language does not include said limitation.

2. The applicant has argued: "Rowland does not teach or even relate to an electronic photo album as does Hornback and the claimed invention. Accordingly, one skilled in the art would at the time the present invention was made would have had no reason to look for the teachings in Rowland in order to improve upon Hornback." However, the teaching that an ASIC is an equivalent substitute for a CPU pertains to hardware implementation and not to the field of endeavor in Rowland. One of ordinary skill would have had knowledge of different methods of hardware implementation, regardless of the field of endeavor.

3. The applicant has argued: "Neither an ASIC nor a PLD is an 'equivalent substitute' for a CPU (for example, try replacing the Pentium CPU in a computer with any ASIC or PLD – it will not work)." However, "CPU" is a general term for a central controller in a computing system, and is not restricted to Pentium CPUs for use in high-end computers.

4. Applicant's other arguments have been considered but are moot in view of the new ground(s) of rejection.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4, 6, 8, 22, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Edwards, U.S. Patent 4,754,271.

Regarding claim 1, Edwards teaches a portable electronic photo album comprising: a housing structure that fits within a pocket-sized structure (col. 1, line 66-col. 2, line 5); an electronic display (LCD 29), located within the housing, capable of displaying digital images (col. 2, lines 41-42, Fig. 2); memory (ROM cartridge 13), located within the housing, that stores one or more digital images (col. 3, lines 5-6; Fig. 2); and dedicated processing circuitry (main control logic 27), located within the housing and being coupled to the memory and the display, the processing circuitry being substantially dedicated to displaying on the electronic display the one or more digital images stored in the memory (col. 3, line 65-col. 4, line 4). It is an inherent quality of a housing that fits within a pocket-sized structure to fit within a pocket-sized wallet as well.

Regarding claim 22, because the apparatus of claim 1 is taught, the method corresponding to the apparatus is also taught.

Regarding claim 4, Edwards teaches that the housing includes at least one user input device (pushbutton 30) for advancing which digital image is displayed on the electronic display (col. 3, line 64-col. 4, line 4).

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Regarding claim 6, Edwards teaches that the electronic display is a liquid crystal display (col. 2, line 42).

Regarding claim 8, Edwards teaches that digital images are loaded into the ROM from a VCR and read-write buffer (col. 2, lines 53-68). The electrical connector mounted to the housing and cable connected to the connector for transferring digital images are inherently taught.

Regarding claim 25, because the apparatus of claim 8 is taught, the method corresponding to the apparatus is also taught.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 3, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, U.S. Patent 4,754,271, in view of Rowland et al, U.S. Patent 5,801,970.

Regarding claims 2 and 3, Edwards teaches the apparatus of claim 1. See above. Edwards does not teach an ASIC or PLD. However, it is well known that ASICs and PLDs are equivalent substitutes for processing circuitry CPUs. Rowland teaches that a data processor may be a CPU, ASIC, or programmable logic array (col. 4, lines 49-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use either an ASIC or PLD in place of the CPU of Edwards, as the units are equivalent substitutes.

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Regarding claims 23 and 24, because the apparatuses of claims 2 and 3 are taught, the methods corresponding to the apparatuses are also taught.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, U.S. Patent 4,754,271, in view of Eisele et al, U.S. Patent 6,089,459.

Regarding claim 5, Edwards teaches the apparatus of claim 1. See above. Edwards does not teach that the electronic display also displays at least one user input location for advancing which digital image is displayed on the electronic display. It is well known in the art to provide touch screens instead of control keys on the display of various devices. This would reduce the overall weight of the device and make it more compact. Eisele et al discloses a device for displaying graphical data that uses an optical touch screen provided for its control keys (col. 8, lines 57-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure Edwards' device with the touch screen display taught by Eisele to make an electronic photo album with a touch screen display that displays at least one user input location for advancing which digital image is displayed on the electronic display. One of ordinary skill would have been motivated to make such a modification to make the device lighter and more compact.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, U.S. Patent 4,754,271, in view of Eisele et al, U.S. Patent 6,089,459, and further in view of Akins et al, U.S. Patent 5,623,280.

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Regarding claim 7, Edwards in view of Eisele teach the apparatus of claim 6. See above. Edwards in view of Eisele do not teach a substantially flexible liquid crystal display. Akins teaches a flexible liquid crystal display with touch sensitive screen, and Akins also teaches that the plastic substrates used in the manufacture of the flexible LCDs are thinner, lighter, less susceptible to breakage, and lend themselves more readily to the manufacturing process (col. 1, lines 45-52). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the flexible LCD of Akins in the apparatus of Edwards in view of Eisele. One of ordinary skill would have been motivated to make such a modification to make the apparatus lighter, more compact, and less susceptible to damage.

9. Claims 9-13, 26, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, U.S. Patent 4,754,271, in view of Hornbeck, PCT WO 99/56463.

Regarding claim 9, Edwards teaches the apparatus of claim 1. See above. Edwards teaches an electrical connector and cable for transferring digital images from the VCR to the ROM. See above. Edwards does not teach an infrared I/O port for loading images. Hornbeck teaches an infrared I/O port, wherein the digital images are loaded into the memory via the infrared I/O port (page 7, lines 19-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the I/O port of Hornbeck into the apparatus of Edwards. One of ordinary skill would have been motivated to make such a modification to transfer data without using physical connectors.

Regarding claim 10, Edwards teaches the apparatus of claim 1. See above. Edwards teaches an electrical connector and cable for transferring digital images from the VCR to the

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ROM. See above. Edwards does not teach a FLASH memory connector, wherein digital images are loaded into memory via FLASH card. Hornbeck teaches that an electronic photo album may accept a flash card and therefore a FLASH memory connector, wherein the digital images are loaded into memory via a FLASH card connected to the FLASH memory connector (page 2, lines 11-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a FLASH memory connector taught by Hornbeck into the apparatus of Edwards. One of ordinary skill would have been motivated to make such a modification to transfer data using a portable, efficient means.

Regarding claim 11, Edwards teaches a portable electronic photo album system comprising: a portable electronic photo album that includes an electronic display (LCD 29) (col. 2, lines 41-42, Fig. 2), memory (ROM cartridge 13) (col. 3, lines 5-6; Fig. 2), and dedicated processing circuitry (main control logic 27) that displays one or more digital images stored in the memory (col. 3, line 65-col. 4, line 4). Edwards teaches that the electronic photo album possesses a housing that fits within a pocket-sized structure (col. 1, line 66-col. 2, line 5). It is an inherent quality of a housing that fits within a pocket-sized structure to fit within a pocket-sized wallet as well. Edwards also teaches means for capturing one of more digital images (col. 2, lines 40-52), but does not teach a computer that receives the captured images and sends the images to the portable photo album for storage in the memory. Hornbeck teaches a computer from which a photo album can download images (Fig. 7; Fig. 4, item 404; page 7, lines 25-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the computer of Hornbeck with the electronic photo album of Edwards to make a system in which the camera captures images and sends them to the computer, and thereafter a



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user can download the images onto an electronic photo album. One of ordinary skill would have been motivated to make such a modification to provide enhanced image processing of pictures prior to storage.

Regarding claim 26, because the apparatus of claim 11 is taught, the method corresponding to the apparatus is also taught.

Regarding claim 12, Hornbeck teaches a common interface between computer, camera, and photo album (Fig. 7A).

Regarding claim 13, Edwards teaches a digital still camera (col. 2, lines 51-52).

Regarding claim 30, see comments for claim 11. Hornbeck teaches a memory card interfaced with the photo album for storing digital images (Fig. 4; page 7, lines 12-16).

Regarding claim 31, Hornbeck teaches that image data is loaded from the memory card into internal storage device 402 and displayed from there (Fig. 7A, items 710, 711, and 200; page 11, lines 22-28), which reads on circuitry acting to swap image from the memory card into the display memory.

10. Claims 14-18, 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, U.S. Patent 4,754,271, in view of Hornbeck, PCT WO 99/56463, and further in view of Ohta et al, U.S. Patent 6,577,760.

Regarding claims 14-16, Edwards in view of Hornbeck teach the apparatus of claim 11. See above. Edwards in view of Hornbeck do not teach that the means for capturing images is a scanner, a CD-ROM, or a floppy disc. Ohta teaches that images can be directly loaded onto a computer from a scanner, CD-ROM, and floppy disc (Fig. 21; col. 14, lines 57-67; col. 15, lines

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1-8). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Edwards in view of Hornbeck so that a scanner, CD-ROM, or floppy disc could provide the digital images. One of ordinary skill would have been motivated to make such a modification to provide a user with multiple means for obtaining desired digital images.

Regarding claims 27, 28, and 29, because the apparatuses of claim 14-16 are taught, the methods corresponding to the apparatuses are also taught.

Regarding claim 17, Edwards in view of Hornbeck teach the apparatus of claim 11. See above. Edwards in view of Hornbeck do not teach that the computer includes application software for manipulating the digital images. Ohta teaches application software for manipulating the digital images (col. 5, lines 8-43). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the application software of Ohta in the invention of Edwards in view of Hornbeck so that obtained images can be manipulated. One of ordinary skill would have been motivated to make such a modification to obtain higher quality images.

Regarding claim 18, Hornbeck teaches a computer monitor (Fig. 4). As Edwards in view of Hornbeck in view of Ohta teach that images are manipulated and downloaded to an album, it would have been obvious to display an image on the monitor exactly as it would appear on the electronic display of the portable photo album.

11. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, U.S. Patent 4,754,271, in view of Halpern, U.S. Patent 6,173,897.

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Regarding claim 19, Edwards teaches a portable electronic photo album comprising: a housing shaped like a thin plastic card that fits within a pocket-sized structure (col. 1, line 66-col. 2, line 5); an electronic display (LCD 29), located within the housing, capable of displaying digital images (col. 2, lines 41-42, Fig. 2); memory (ROM cartridge 13), located within the housing, that stores one or more digital images (col. 3, lines 5-6; Fig. 2); and dedicated processing circuitry (main control logic 27), located within the housing and being coupled to the memory and the display, the processing circuitry being substantially dedicated to displaying on the electronic display the one or more digital images stored in the memory (col. 3, line 65-col. 4, line 4). Edwards does not teach a pocket-sized wallet comprising a body that includes one or more slots for storing credit cards, and one or more sections for storing money, the body being sized to fit within a pocket, wherein the electronic photo album is stored in the wallet. Halpern teaches the practice of placing a card in a wallet that fits in a shirt pocket (col. 6, lines 6-8). The slots for storing credit cards and sections for storing money are inherently taught. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the practice of placing cards in wallets taught by Halpern with the card-sized electronic photo album taught by Edwards to make a portable electronic photo album wallet in which an electronic photo album is stored. One of ordinary skill would have been motivated to make such a modification to store a card-sized device in a wallet already used for carrying card-sized items.

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12. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, U.S. Patent 4,754,271, in view of Halpern, U.S. Patent 6,173,897, in view of Rowland et al, U.S. Patent 5,801,970.

Regarding claims 20 and 21, Edwards in view of Halpern teach the apparatus of claim 19. See above. Edwards does not teach an ASIC or PLD. However, it is well known that ASICs and PLDs are equivalent substitutes for processing circuitry CPUs. Rowland teaches that a data processor may be a CPU, ASIC, or programmable logic array (col. 4, lines 49-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use either an ASIC or PLD in place of the CPU of Edwards, as the units are equivalent substitutes.

13. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, U.S. Patent 4,754,271, in view of Hornbeck, PCT WO 99/56463, and further in view of Eisele et al, U.S. Patent 6,089,459.

Regarding claim 32, Edwards in view of Hornback teach the apparatus of claim 30. See above. Edwards in view of Hornback do not teach that processing circuitry displays images on the electronic display directly from image data stored on the memory card. Eisele teaches a device for displaying graphical data directly from a smart diskette that may include a flash card. Eisele's display device has no memory but uses the memory and the circuitry contained on the diskette/flash card. The device thus displays the data directly from the memory card (Fig. 3, items 103 and 200; Figs. 9A and 9B; Fig. 12, items 1201 and 1202; col. 11, lines 41-52; col. 15, lines 8-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time

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the invention was made to configure the device of Edwards in view of Hornback for displaying images directly from image data stored on a memory card taught by Eisele. One of ordinary skill would have been motivated to make such a modification to provide an option of a less expensive device by utilizing common conventional removable memory storage media.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dorothy Wu whose telephone number is 703-305-8412. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

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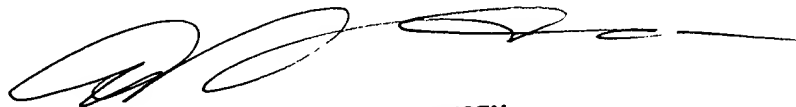
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on 703-308-9644. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Dorothy Wu*

DW

March 30, 2004



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